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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/461,876	12/15/1999	ALAN EUGENE FREY	991165	4390

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EXAMINER

DO, NHAT Q

ART UNIT	PAPER NUMBER
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2663

DATE MAILED: 09/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/461,876

Applicant(s)

FREY ET AL.

Examiner

Nhat Do

ND

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Allowable Subject Matter*

1. The indicated allowability of claims 1-5, and 7 are withdrawn in view of the newly discovered reference(s) to U.S. Patent No. 6,141,342 to Cheesman et al, and U.S. Patent 5,956,396 to Ash et al. Rejections based on the newly cited reference(s) follow.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 6, 8, 9, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,995,606 to Civanlar et al.

Regarding to claim 6, Civanlar et al disclose a system that:

Forwarding to a server signaling associated with the initial of the call (Fig. 1, 3; col. 4, line 53-col. 5, line 5);

Determining that the call invokes a feature that cannot be provided by the packet-based network (Fig. 1, 3; col. 3, lines 20-47; col. 4, lines 57-63);

Routing the call from the packet-based network to a circuit-switch network (Fig. 1, 3; col. 5, lines 32-42);

Processing the call on the circuit-switch network (Fig. 1, 3; col. 5, lines 45-47).

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Regarding to claim 8, Civanlar et al disclose the step of assessing the initial address message (Col. 3, lines 20-30).

Regarding to claim 9, Civanlar et al disclose the server assesses the client's account for phone number and for connecting the call (Col. 4, line 64-col. 5, line 5; col. 5, lines 39-44). The examiner understands that the phone number is a trunk selection parameter; therefore it is inherent that Civanlar et al disclose assigning a trunk selection parameter corresponding to the feature invoked by the call.

Civanlar et al further disclose routing the call onto a trunk (through modem 2) among a plurality of trunks based on the trunk selection parameter (fig. 2).

Regarding to claim 11, Civanlar et al disclose in figures 9, and 10 a system performing:

Selecting the server 130 (destination call processing entity) within the packet network by the client 100 (first call processing entity). The server connects to the switched network trunk through the ISDN adapter 605 (Fig. 9, and 10);

Sending a request including user's phone number (truck selection parameter) from the client 100 (first call processing entity) to the server 130 (destination call processing entity) (Fig. 10, step 1003);

Routing the call through the ISDN based on the user's phone number (Fig. 10, steps 1004, and 1005).

4. Claims 1, 2, 6-8, 10, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,141,342 to Cheesman et al.

Regarding to claim 6, Cheesman et al disclose a system in figure 3 performing:

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Forwarding to the call manager 42 (packet network feature server) an IAM message (Col. 7, lines 14-16);

Determining if the call invokes feature that cannot be provided by the ATM network (packet based network) (Col. 7, lines 19-35);

Routing the call to the access tandem 18 for processing the call using PSTN 64 (Col. 4, lines 35-37).

Regarding to claim 7, Cheesman et al disclose:

Sending the IAM message to the SSC 44 (connection gateway) (Col. 7, line 14).

Regarding to claim 8, Chessman et al also disclose the cal manager 42 assesses the IAM message to determine the call feature (Col. 7, lines 19-35).

Regarding to claim 10, Cheesman et al disclose the system is controlled by SS7 network (Col. 9, lines 23-39).

Chessman et al also disclose routing the call to a gateway of another ATM subnetwork for further forwarding the call (Col. 7, lines 38-39).

Regarding to claim 11, Cheesman et al disclose:

The call manager 42 (first call processing entity) sends fabric control messages to the appropriate MSPs (destination call processing entities) for setting up the call connection (Col. 7, lines 19-29). It is inherent that the appropriate MSPs are selected by the call manager 42 prior to sending fabric control messages. Cheesman also disclose the call is routed to the access tandem 18 through the sub-network 25 when the sub-network 25 cannot terminate the feature call (Col. 7, lines 32-37). Therefore, from figure 3, the MSP 41 (destination call processing entity) must be selected by the call manager in the case the call is redirected to PSTN 64;

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The fabric control message is considered the truck selection parameter because the MSP uses the message to set up CVS and channels in the truck.

Regarding to claim 1, Cheesman et al disclose a system in figure 3 comprising:

The EO 12 (circuit switched network switch) routes the call onto the first voice trunk 27, and transmits the IAM to the CM 42 (figure 4, first step);

The MSP 35 (first packet voice gateway) couples the first truck 27 and the ATM network 25;

The SSC 44 (first connection gateway) receives the IAM (Col. 7, line 14);

The CM 42 (feature server) receives the IAM from the SSC 44, and conveys routing message to the MSP 41 (second connection gateway) if the invoked feature cannot be provided by the CM 42 (feature server) (Col. 7, lines 20-37);

The MSP 41 (second connection gateway) selects the second truck 33, which connects to the AT 18 (second circuit switched switch);

The MSP 41 is also the second packet voice gateway since Cheesman disclose the MSPs map the SVCs to the CICs indicated by the CM 42 to be the channels in the trunk groups (27, 33...) which is equivalent to the claimed setting up connection between the packet based network and the second truck;

The AT 18 (second circuit switched switch) connects to the PSTN.

Regarding to claim 2, the PSTN is a circuit switched network.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Civanlar et al as applied to claim 6 above, and further in view of U.S. Patent No. 6,411,704 to Pelletier et al.

Civanlar et al disclose routing the call to a second packet gateway (server N) for further transmission via the packet-based network (Fig. 1, 3; col. 5, lines 35-38).

Civanlar et al fail to disclose implementing the invoked feature on an SS7 network. Pelletier et al disclose using SS7 for controlling a PSTN network is well know (Col. 4, lines 25-57). It would have been obvious to a person having ordinary skill in the art by the time the invention was made to implement the invoked feature on an SS7 network in the communication system in figure 2 taught by Civanlar et al. A skilled artisan would have been motivated to so in order to control the PSTN parts of the system.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cheesman et al.

Cheesman et al fail to disclose explicitly the AT 18 (second circuit switched switch) routes the call to a third packet voice gateway for further routing the call through a packet network. However, Cheesman et al disclose when the ATM network 25 cannot support the featured call, the call can be routed though the PSTN 64 or another ATM sub-network (Col. 7, lines 32-39). A skilled artisan would have been motivated to modify the AT 18 so that it routes the call to another ATM sub-network coupled to it that can support the featured call. The motivation is to minimize the cost as suggested by Cheesman et al (Col. 2, lines 11-16).

Therefore, it would have been obvious to a person having ordinary skill in the art by the time the

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invention was made to design the AT 18 so that it routes the call to a third packet voice gateway for further routing the call through a packet network.

8. Claims 4, 5, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheesman et al as applied to claim 6 above, and further in view of U.S. Patent No. 5,956,396 to Ash et al.

Cheesman et al fail to disclose routing the featured calls onto one of trunks based on an assigning truck selection parameter (TSP).

Ash et al disclose a telephone system in figure 1, wherein featured calls are routed based on the routing index RI (Applicant's TSP) (Fig. 2). Therefore, it would have been obvious to a person having ordinary skill in the art by the time the invention was made to include a truck selection parameter (TSP) in the fabric control messages sent from the CM 42 to the MSP 41, and let the MSP 41 select a truck on the trunk group 33 based on an assigning truck selection parameter (TSP). A skilled artisan would have been motivated to do so in order to employ the benefit taught by Ash et al, which is increasing the efficiency of the switching system (Col. 1, lines 53-67).

### ***Response to Arguments***

9. Applicant's arguments with respect to claim 11 have been considered but are moot in view of the new ground(s) of rejection.

10. Applicant's arguments filed on 06/24/03 regarding to the rejection of claims 6, 8, 9, and 10 have been fully considered but they are not persuasive.

Applicant discloses on page 6 of the Remark that Civanlar et al fail to disclose forwarding to a packet network server signaling associated with initiation of the call. In reply,



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Civanlar et al disclose the client makes a service request (Col. 4, line 55). The server uses the service request, which includes client ID, phone number... to process the service request (Col. 4, lines 64-66). The examiner is in the position the service request is the signaling associated with initiation of the call and the server is the packet network server.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nhat Do whose telephone number is (703) 305-5743. The examiner can normally be reached on 8:30 AM - 5:30 PM Monday - Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on (703) 308-5340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Nhat Do  
Examiner  
Art Unit 2663

ND

August 29, 2003

  
MELVIN MARCELO  
PRIMARY EXAMINER